

## REMARKS

In accordance with the foregoing, claim 2 is amended and claims 16-18 are presented. No new matter is presented in any of the foregoing and, accordingly, approval and entry of the amended and new claims are respectfully requested. Claims 1 and 5-15 were withdrawn by the Examiner.

Claims 2-4 and 16-18 are pending and under consideration.

## CLAIM AMENDMENT

Claim 2 is amended herein to clarify that an information presentation device includes "accepting means for accepting a selection of a product or service . . . based on the search parameters designated by the user." No new matter is presented in any of the foregoing and, accordingly, approval and entry of the amended claim are respectfully requested.

## PAGE 2: REJECTION OF CLAIMS 2-4 UNDER 35 U.S.C. §112, SECOND PARAGRAPH

The Examiner rejects claims 2-4 under 35 U.S.C. §112, second paragraph as being indefinite. The Examiner contends that it is unclear whether "applicant is invoking 112 6<sup>th</sup> paragraph language for the elements referred to as accepting means and the parameter storage means." (Action at page 2).

The Examiner indicates "in order for Applicant's next response to be deemed responsive, a statement either affirming or not affirming the invocation of 112 6<sup>th</sup> paragraph must be made."

Accordingly, Applicants affirm that claims 2-4 are means-plus-function claims as discussed in 35 U.S.C. §112, 6<sup>th</sup> paragraph. Applicants also respectfully point out that in the Office Action mailed January 6, 2005 (previous Action) the Examiner indicated his understanding of claims 2-4 by stating "means plus function claim as elected in claims 2-4 (emphasis added)." (Previous action at page 2).

Applicants submit that claims 2-4 comply with 35 U.S.C. §112, second paragraph and request that the rejection be withdrawn.

## PAGES 2-3: REJECTION OF CLAIM 2 UNDER 35 U.S.C. §102(e) AS ANTICIPATED BY REVASHETTI ET AL. (U.S.P. 6,370,578)

The Examiner rejects claim 2 under 35 U.S.C. §102(e) as anticipated by Revashetti. (Action at pages 2-3). The rejection is traversed.

## Features Not Taught By Cited Art

Revashetti does not support an anticipatory-type rejection by not teaching, for example, features recited by claim 2, as amended, of an information presentation device including "accepting means for accepting a selection of a product or service . . . retrieved based on the

search parameters designated by the user" nor "parameter storage means for storing the search parameters." For example, a "search parameter" is specified by a character string or numbers that the user has designated, and a plurality of numbers, for example, be assigned to one application.

Revashetti merely teaches a method to automatically register and store an application as environment information of a user's computer when the application software is installed into the computer, and to acquire version information of the installed applications therein and determine whether sales of an upgraded application to the user is possible by obtaining the registered and stored environment information from the computer.

According to an aspect of the present invention, a user first inputs (designates) search parameters. Products or services that match the parameters are extracted. The user then selects a desired product or service (*arguendo* corresponding to an application taught by Revashetti) from the extracted products and services, and then, the selected product and service are associated with the search parameters and are stored.

Thus, according to the present invention, it is possible to deduce the needs and purposes the user had in mind when he/she selected the product and service based on the stored search parameters associated therewith. Accordingly, providers of the product or service can provide more effective advertisements or introduce better products or services to the user by looking-up the selected product or service.

Revashetti, however, merely teaches information that is associated with an application program and stored (i.e., information that is associated with a Registry key and stored) is information that is uniquely preset for each application. Thus, information associated with each application program and stored is always the same, regardless of which user installs the application. Thus, it is not possible to deduce why the user installed the application based on the information stored therein.

According to an aspect of the present invention, if a product or service is *arguendo* an application, a user inputs (designates) search parameters to search applications that he/she needs, and then applications that match the parameters are searched and extracted. Then, an application selected by the user and the search parameters are associated and stored. According to aspects of the present invention, a service provider does not look-up information which is unique to each application (i.e., same information regardless of the user who installs an application), but rather search parameters which reflect the purposes and needs for each user i.e., different information for each user.

In addition, the Examiner mistakenly contends that recited "search parameters" is taught by Revashetti's teaching of a "key" in the Windows Registry. (Action at page 3).

However, a Registry key in Windows, as taught by Revashetti, is not designated by a user, but solely by an Operating System. Such a key is singly assigned to an application installed in a client computer, and a plurality of keys cannot be assigned to one application.

Assuming *arguendo* that the Examiner's contention is correct then it would necessarily follow that Revashetti would teach an active marketing host program selecting an application from a current configuration of a client computer, e.g., a "selection of a product being searched with a key" (accepting means). However, Revashetti does not teach a parameter "storage means," or *arguendo* a "storage" of a key for the selected product or service together with user identification information. Rather, Revashetti teaches (see, for example, col. 3, lines 51-55) that:

(i)n a preferred embodiment, a product information database, a marketing rule knowledge base and an opportunity detection object are downloaded to a client computer from a service provider computer system.

That is, product information is merely presented to the user.

#### **Examiner's Contentions Not Supported**

Further, claim 2 recites "identifying said first user terminals that have selected a first product as a candidate for purchase." The Examiner mistakenly contends:

together with user identification information that identifies said user terminal (analysis is particular to a given computer col. 6 lines 61-63 and hence inherently must include identification of the client computer 208).

Applicants submit that Revashetti merely teaches (col. 6, lines 60-62) to "analyze the current configuration of the client computer."

Further, Applicants submit that the Examiner has not provided any support for the inherency that analysis of a current configuration teaches "identification" of a client computer, let alone identifying "first user terminals that have selected a first product as a candidate for purchase."

Applicants respectfully traverses the Examiner's statement and demands the Examiner produce authority for the statement. The Applicant specifically points out the following errors in the Examiner's action. First, the Examiner uses common knowledge as evidence for the rejection. Second, the noticed fact is not considered to be common knowledge or well-known in the art. In this case, the limitation is not of notorious character or capable of instant and unquestionable demonstration as being well-known. Instead, this limitation is unique to the present invention. See M.P.E.P. § 2144.03(A) ("the notice of facts beyond the record which may be taken by the Examiner must be "capable of such instant and unquestionable demonstration

as to defy dispute"). For example, a configuration can be identified as having a hard drive, along with a multitude of other computers so identified, but such identification does not identify first user terminals that have selected a first product as a candidate for purchase.

Third, it appears that the Examiner also bases the rejection, at least in part, on personal knowledge. The Examiner is required under 37 C.F.R. § 1.104(d)(2) to support such an assertion with an affidavit when called for by the Applicants. Thus, Applicants calls upon the Examiner to support such assertion with an affidavit.

### **Conclusion**

Since features recited in claim 2 are not taught by the cited art and the Examiner's contentions are not supported, the rejection should be withdrawn and claim 2 allowed.

### **PAGES 35: REJECTION OF CLAIMS 2-4 UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER REVASHETTI IN VIEW OF WELSH ET AL. (U.S.P. 6,757,691)**

The Examiner rejects claims 2-4 under 35 U.S.C. §103(a) as being unpatentable over Revashetti in view of Welsh et al.

Claims 3-4 recite an information presentation device including "user reference request accepting means for accepting user reference requests from first group of computer terminals on said network; and parameter providing means for extracting from said parameter storage means a first user identification information identifying said first user terminals that have selected a first product as a candidate for purchase that is provided by an administrator of a provider terminal included in said first computer terminals, and search parameters that each of said first user terminals has set to said first product, and providing them to said provider terminal."

The Action concedes that Revashetti does not teach features recited by claims 3 and 4. (Action at page 4). However, the Examiner contends there is motivation to modify Revashetti with Welsh for "the ability to categorize(d) groups of users or people who like a certain product for ease in mass marketing." (Action at page 5).

Applicant submits there is no motivation or reasonable chance of success to modify as the Examiner contends. As set forth in MPEP §2144. 04:

(t)he mere fact that a worker in the art could rearrange the parts of the reference device . . . is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation . . . without the benefit of appellant's specification, to make the necessary changes in the reference device.

Applicants submit there is no reasonable chance of success to modify a system taught by Revashetti that teaches marketing based on a current computer configuration with a system taught by Welsh of marketing of based on a predicted behavior.

## Summary

Since there is no reasonable chance of success to combine the art in a manner as the Examiner suggests, *prima facie* obviousness is not established, the rejection should be withdrawn and claims 2-4 allowed.

## NEW CLAIMS

New claims 16-18 recite features of the present invention in a different fashion. Claims 16-18 recite an information presentation device for a user terminal on a network in which a user retrieves products or services that match search parameters designated by the user including "a first controller accepting a selection of a product or a service that is included in the products or the services that were retrieved based on the search parameters designated by the user based on the search parameters designated by the user."

These, and other, features of claims 16-18 patentably distinguish over the cited art, and they are submitted to be allowable for the recitations therein.

## CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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